

## **REMARKS/ARGUMENTS**

The rejections presented in the Office action dated August 12, 2005 have been considered. Claims 1-16 are currently pending in the application, with Claims 15-16 being added. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Claims 1-14 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent Publication No. 2002/0069078 to Goldstein (hereinafter “*Goldstein*”) in view of U.S. Patent Publication No. 2004/0203674 to Shi et al. (hereinafter “*Shi*”). The Applicant respectfully traverses the rejection.

Regarding independent Claims 1 and 11, the Office Action cites *Goldstein* as teaching a system and method for creating custom wallpaper. Before specifically addressing the claimed limitations of Claims 1 and 11, the Applicant respectfully contests the application of *Goldstein* to the claims of the pending application. As unequivocally stated and described in *Goldstein*, *Goldstein* relates “**to custom wallpaper to be applied to walls**” (*Goldstein*, FIELD OF THE INVENTION; emphasis added). *Goldstein* relates to an application, that is executed on a computer system, that allows a purchaser to specify the type of wallpaper that can be glued to walls. As will be described more fully below, this is unrelated to the present invention and for various reasons significantly contributes to the failure *prima facie* obviousness based on the cited combination of references.

During examination, an examiner is entitled to give the broadest “reasonable” interpretation of the claims (M.P.E.P. §2111). This interpretation must, among other things, be reasonable, consistent with the specification, and recognizable as the meaning to a person of ordinary skill “in the art in question at the time of the invention.” (M.P.E.P. §§ 2111, 2111.01). In the present case, the Examiner has equated “wallpaper” that is glued to structural walls with the now well-known terminology of “wallpaper” as referred to in connection with graphical displays. It is respectfully submitted that this correlation is misplaced. The fact that the glue-type wallpaper can be viewed via an application does not transform the “wallpaper” to the what is referred to as “wallpaper” in the present invention. It is known to those skilled in the computing and telecommunication arts that common terms are given special meaning in such technological areas. For example, the term “mouse” is known to those in the computing and

telecommunication arts, and the plain meaning of such a term is not known to persons in such technological areas as a living animal. Terms such as “mouse,” “wallpaper,” and the like are often taken from everyday language and given special meaning in the art of computing systems, telecommunications, etc.

Thus, the Applicant respectfully submit that the application of *Goldstein* to Claims 1 and 11, while possibly the broadest interpretation, is not the broadest “reasonable” interpretation, and is not “consistent with the specification.” *See, e.g., In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). The broadest reasonable interpretation of the claims must be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). The Applicants respectfully submit that those skilled in the art would not reach the interpretation of physical glue-type wallpaper when considered in view of the Applicant’s Specification. For at least this reason, the Applicant respectfully submits that the interpretation of “wallpaper” and the consequent citing of *Goldstein* is not commensurate with the broadest “reasonable” interpretation of these claims.

To the extent that the Examiner is relying on what might be the plain meaning of the term wallpaper, as stated above, in this art the term “wallpaper” is known to be of the type of graphical background display as used in the Applicant’s Specification and claims. For example, in paragraph 28 of the Applicant’s Specification, it states:

[0028] In modern terminals, the display 212 is able to show graphics, either in black-and-white or in colour. Thus, in some terminals, what is known as a wallpaper can be shown on the display, in the same fashion as graphical user interfaces of computers. The wallpaper is constantly shown on the display, and other objects presented on the display, such as icons and open documents, are shown on the wallpaper. Figure 3 illustrates an example of the wallpaper. The Figure shows a terminal 100 comprising a display 302. The display includes a wallpaper 304, and a number of icons 306A to 306C are shown on the wallpaper that allow the user to start programs and functions of the terminal.

Thus, not only is this term known to those skilled in the art, the Applicant’s Specification defines this term such that it is clearly distinguishable from commercial or residential glue-type wallpaper, whether or not a representation of that glue-type wallpaper is

displayed via an application on a computer. As is stated in M.P.E.P. § 2111.01(II), “plain meaning” refers to the ordinary and customary meaning given to the term by those of ordinary skill in the art. In the recent case of *Phillips v. AWH Corp.*, the Federal Circuit held that the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill **in the art in question** at the time of the invention. *Phillips v. AWH Corp.*, USPQ2d 1321 (Fed. Cir. 2005). The art in question for Applicant’s invention is unrelated to the physical glue-type wallpaper, or as stated as the field of the invention in *Goldstein*, “to be applied to walls.” (*Goldstein*, page 1, paragraph 0001). For at least these reasons, the Applicant respectfully submits that the interpretation applied by the Examiner to independent Claims 1 and 11, as they relate to the term “wallpaper,” is unreasonably broad, and therefore the combination of references including *Goldstein* fail to establish *prima facie* obviousness.

Referring specifically to Claim 1, the method is for controlling a display in a terminal, where a wallpaper is displayed on the display. As indicated above, *Goldstein* does not, as is suggested in the Office Action, involve displaying a wallpaper on the display as the term “wallpaper” is recognized to those skilled in this art and as would be consistent with the Applicant’s Specification. The Office Action also indicates that *Goldstein* teaches changing properties of a wallpaper on the display, and again the Applicants respectfully submit that this is not taught in *Goldstein*, as would be recognized to those skilled in this art as would be consistent with the Applicant’s Specification. The other cited reference, *Shi*, does not remedy these deficiencies – *i.e.*, neither *Goldstein* nor *Shi*, either alone or in combination, involve the wallpaper and consequently the claimed limitations involving the wallpaper of Claim 1. For at least this reason, the combination of *Goldstein* and *Shi* fail to teach or suggest all the claim limitations as is required under M.P.E.P. § 2143 to establish *prima facie* obviousness.

Further, notwithstanding the Examiner’s interpretation of “wallpaper,” the cited combination still fails to teach or suggest all the limitations of Claim 1. Claim 1 indicates that the properties of the wallpaper on the display are changed “in response to the remaining amount of prepaid telecommunications costs.” Thus, in Claim 1, there is a relationship between the changing of the displayed wallpaper and the remaining amount of prepaid telecommunication costs. The Examiner acknowledges that *Goldstein* fails to teach this relationship, but mentions

that *Goldstein* discloses a server that can accept payment for wallpaper, and cites *Shi* as disclosing money remaining for pre-paid phone calls. However, neither of these cited portions of either of these references teaches or suggests the relationship of changing the wallpaper (regardless of the interpretation of this term) *in response to* the remaining amount of prepaid telecommunication costs. For at least this additional reason, *prima facie* obviousness has not been established.

It is further submitted that *Shi* relates to display management for devices, and *Goldstein* relates to creating glue-type wallpaper. To establish a *prima facie* case of obviousness based on a combination of references, three basic criteria must be met, as is set forth in M.P.E.P., §2143:

- 1) There must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) There must be a reasonable expectation of success; and
- 3) The prior art references must teach or suggest all of the claim limitations.

Thus, in addition to having to show that the cited combination of references teach or suggest all of the claim limitations, the Examiner must show a motivation to combine these references, and there must be a reasonable expectation of success. The Applicant respectfully submits that these requirements have not been met.

Regarding motivation, the motivation to combine these references provided in the Office Action is “to provide the customer the choice of creating custom wallpaper depend on money left.” This is clearly not a motivation to combine the references, but rather is a generalized statement of what is set forth in the Applicant’s Claim 1. There is nothing in the references themselves, the problem to be solved, or what is in the ordinary skill in the art that would lead to the combination of references – rather, the proffered motivation is clearly made in hindsight, as it simply recites what is generally set forth in a portion of Claims 1 and 11.

The examiner must show some objective teaching leading to the combination. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). It is respectfully submitted that there is no such objective teaching in either reference that leads to the combination of the references, and it is respectfully submitted that aspects purportedly found in the prior art have been pieced together to arrive at the invention through hindsight. As stated by the Federal Circuit:

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.

*In re Dembicza*k, 50 USPQ2d 1614, (Fed. Cir. 1999) (*citing Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985)). Without a suggestion of the desirability of "the combination," a combination of such references is made in hindsight, and the "range of sources available, however, does not diminish the requirement for actual evidence." *Id.* It is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown, and that this evidence be "clear and particular." *Id.* Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

For at least the aforementioned reasons, the Applicant respectfully submits that *prima facie* obviousness also fails for want of a proper motivation to combine the cited references.

Another requirement to establish *prima facie* obviousness is a reasonable expectation of success (M.P.E.P. § 2143.02). Thus, the Examiner must establish that any alleged determination of "money left for pre-paid phone calls" can be successfully 1) displayed on the "wallpaper to be applied to walls" of *Goldstein*, and 2) that the properties of the wallpaper to be applied to walls changes in response to the money left for pre-paid phone calls. The Applicant respectfully submits that the wallpaper to be applied to walls of *Goldstein* is incapable of displaying, and having its properties changed, in response to any amounts remaining for pre-paid phone calls. For at least these reasons, the Applicant respectfully submits that there is no reasonable expectation of success to combine the cited references, and again *prima facie* obviousness fails.

For at least the aforementioned reasons, it is respectfully submitted that *prima facie* obviousness has not been established for the cited combination of references, and Claim 1 is not rendered obvious by the combination of *Goldstein* and *Shi*. Reconsideration and allowance of Claim 1 is respectfully submitted.

Claim 11 is directed to a terminal having a graphic display arranged to display a wallpaper, and to change the properties of the wallpaper shown on the display in response to the remaining amount of prepaid telecommunication costs. The reasons set forth above in

connection with independent Claim 1 are also applicable to independent Claim 11, and therefore Claim 11 is not rendered obvious by the combination of *Goldstein* and *Shi*, and is in condition for allowance.

Dependent Claims 2-10 are dependent from independent Claim 1, and dependent Claims 12-14 are dependent from independent Claim 11. These dependent Claims 2-10 and 12-14 also stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of *Goldstein* and *Shi*. While Applicant does not acquiesce with any particular rejections to these dependent claims, including any assertions concerning common knowledge, obvious design choice and/or what may be otherwise well-known in the art, these rejections are moot in view of the remarks made in connection with independent Claims 1 and 11. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. “If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious.” M.P.E.P. §2143.03; *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent Claims 2-10 and 12-14 are also allowable over the combination of *Goldstein* and *Shi*.

As indicated above, Applicant does not acquiesce with any particular rejections to these dependent claims. For example, the Applicant contests the Examiner’s Official notice that the features of Claims 9, 10 and 13 are notoriously well known in the art as is suggested by the Examiner. As stated in M.P.E.P. § 2144.03(A), taking “official notice” requires that these facts are capable of instant and unquestionable demonstration as being well-known. If Official Notice is taken of a fact, and is unsupported by documentary evidence, the technical line of reasoning underlying a decision to take such notice must be clear and unmistakable. (M.P.E.P. § 2144.03(B)). The Examiner has not provided such clear and unmistakable technical line of reasoning in this rejection which is unsupported by documentary evidence. For at least these reasons, the Applicant respectfully submits that the requirements for taking Official Notice have not been met.

Further still, the Applicant does not acquiesce with the particular rejections to the dependent claims. For example, Claim 2 involves showing a portion of the wallpaper “proportional to the amount of telecommunications costs....” It is respectfully submitted that

the cited portions of *Shi*, and *Shi* in general, clearly fail to teach or suggest this limitation, either alone or in combination with *Goldstein*. Nothing in the cited portions of *Shi* suggest the proportional showing of the wallpaper as is recited in this claim. There are various limitations presented in Claims 2-8, 12 and 14, and the Examiner has simply grouped them as being taught/suggested by *Shi*'s alleged teaching of an "amount of telecommunication costs spent and hiding a portion proportional to the amount of remaining telecommunication costs spent."

A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group. M.P.E.P. § 707.07(d). It is respectfully submitted that Claims 2-8, 12 and 14 include numerous limitations not addressed by the Examiner, and thus *prima facie* obviousness has not been established.

For at least the aforementioned reasons, the Applicant respectfully submits that *prima facie* obviousness has not been established for the rejected claims, and the pending claims are not rendered obvious by the cited combination of references. Reconsideration and allowance of the claims are respectfully solicited.

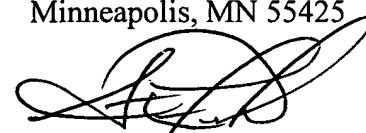
Claims 15 and 16 have been added. It is respectfully submitted that these claims are also allowable over the cited prior art.

If the Examiner believes it helpful, the undersigned attorney of record invites the Examiner to contact him at 952.854.2700 to discuss any issues related to this case.

Respectfully submitted,

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